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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,192	10/16/2001	Stefan Andersson	0119-082	3198

42015 7590 10/22/2008  
POTOMAC PATENT GROUP PLLC  
P. O. BOX 270  
FREDERICKSBURG, VA 22404

EXAMINER
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WILLIAMS, JEFFERY L

ART UNIT	PAPER NUMBER
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2437

NOTIFICATION DATE	DELIVERY MODE
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10/22/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

tammy@ppglaw.com

<b>Office Action Summary</b>	<b>Application No.</b> 09/977,192	<b>Applicant(s)</b> ANDERSSON, STEFAN	
	<b>Examiner</b> JEFFERY WILLIAMS	<b>Art Unit</b> 2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 – 19, 24 – 30, 32 – 52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1 – 19, 24 – 30, 32 – 52 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1 – 19, 24 – 30, 32 – 50, drawn to a cryptographic API and separate device for creating encrypted communications, classified in class 713, subclass 192.
- II. Claims 51 and 52, drawn to operating a SIM-WIM by detecting both the requirement for encryption for a node and detecting the requirement for encryption of an external device and carrying out encryption operations , classified in class 713, subclass 153.

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination requires neither a SIM-WIM that detects cryptographic requirements for nodes and external devices. The subcombination has separate utility such as for providing a SIM-WIM with detection

1 means for applying cryptography to the operations of nodes accessed by the SIM-WIM  
2 card and the operations of external devices.

3 The examiner has required restriction between combination and subcombination  
4 inventions. Where applicant elects a subcombination, and claims thereto are  
5 subsequently found allowable, any claim(s) depending from or otherwise requiring all  
6 the limitations of the allowable subcombination will be examined for patentability in  
7 accordance with 37 CFR 1.104. See MPEP § 821.04(a). Applicant is advised that if  
8 any claim presented in a continuation or divisional application is anticipated by, or  
9 includes all the limitations of, a claim that is allowable in the present application, such  
10 claim may be subject to provisional statutory and/or nonstatutory double patenting  
11 rejections over the claims of the instant application.

12 Restriction for examination purposes as indicated is proper because all these  
13 inventions listed in this action are independent or distinct for the reasons given above  
14 and there would be a serious search and examination burden if restriction were not  
15 required because one or more of the following reasons apply:

16 (a) the inventions have acquired a separate status in the art in view of their  
17 different classification;

18 (b) the inventions have acquired a separate status in the art due to their  
19 recognized divergent subject matter;

20 (c) the inventions require a different field of search (for example, searching  
21 different classes/subclasses or electronic resources, or employing different  
22 search queries);

(d) the prior art applicable to one invention would not likely be applicable to another invention;

(e) the inventions are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

**Applicant is advised that the reply to this requirement to be complete must include (i) an election of a invention to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.**

The election of an invention may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected invention.

If claims are added after the election, applicant must indicate which of these claims are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable

1 over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.  
2 103(a) of the other invention. Any inquiry concerning this communication or earlier  
3 communications from the examiner should be directed to JEFFERY WILLIAMS whose  
4 telephone number is (571)272-7965. The examiner can normally be reached on 8:30-  
5 5:00.

6 If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
7 supervisor, Emmanuel Moise can be reached on (571) 272-3865. The fax phone  
8 number for the organization where this application or proceeding is assigned is 571-  
9 273-8300.

10 Information regarding the status of an application may be obtained from the  
11 Patent Application Information Retrieval (PAIR) system. Status information for  
12 published applications may be obtained from either Private PAIR or Public PAIR.  
13 Status information for unpublished applications is available through Private PAIR only.  
14 For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should  
15 you have questions on access to the Private PAIR system, contact the Electronic  
16 Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a  
17 USPTO Customer Service Representative or access to the automated information  
18 system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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20  
21 J.W.  
22 A.U:2137  
23  
24 /Emmanuel L. Moise/  
25 Supervisory Patent Examiner, Art Unit 2137

